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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,828	11/13/2003	Takashi Aketa	0171-1038P	7856
2292	7590	04/19/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/705,828

Applicant(s)

AKETA ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Claim Objections***

Claims 1-3 are objected to for all of the following reasons:

- (i) claim 1 begins with the phrase "In connection with". It is clear that this portion of the claim was extracted verbatim from the disclosure and this phrase should be eliminated so that claim 1 begins with "A process..."
- (ii) the second step is recited passively so as to not really articulate an affirmative step. It is suggested that "to be applied" in lines 7 and 8 of the claim be deleted and the word "applying" be added at the beginning of line 7.
- (iii) claims 2 and 3 do not properly further limit claim 1 as the latter is directed to a process whereas claims 2 and 3 recite a silicone rubber composition. It is acknowledged that Applicant is attempting merely to further limit the rubber composition used as a sealer along the periphery but the proper way of doing this would be to rewrite these claims as process claims while still incorporating all of the subject matter outlined therein. Applicant might consider rewriting claim 2 as, for example, "the process of claim 1 wherein the silicone rubber for use as a sealer comprises....."

For clarity, Applicant should specify which of the two silicone rubbers is being better defined by claims 2 and 3.

### ***Claims Analysis***

For the purpose of evaluating the instant invention against the prior art, it has been presumed that the "first" silicone rubber, that which lines the inside of the fabric pieces that are mated to form the air bag, may be constituted of any known

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silicone elastomer-forming materials as the original disclosure doesn't appear to place any limitations on this aspect of the invention.

***Allowable Subject Matter***

Claims 1-3 would be allowable if amended to overcome the claim objections set forth *supra*. Applicant furnishes a reference, JP 2001-001854 that mirrors the instant invention in most respects but does not represent an anticipation for the reason that an equivalent silicon rubber sealer is not used around the periphery. Kobayashi, U.S. Patent # 5,106,933 teaches a adhesive silicone composition similar to that disclosed in claim 2 but there is no particular motivation to replace the adhesive agent described by the Japanese document with that taught by Kobayashi insofar as Kobayashi mentions an improved adhesion towards, plastics, phenol resins, and epoxy resins whereas the adhesive employed in JP 2001-001854 would be adhering two silicone-coated surfaces. JP 7-003164 also discloses a composition similar to that in claim 2 but the composition is formulated to have good adhesion to surfaces coated with rust-preventative oil. Again, there would seem to be nothing motivating the skilled artisan to replace the adhesive agent described by JP 2001-001854 with that disclosed in JP 7-003164 A.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 18, 2005

*Marc Zimmer*  
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AU 1712